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EXAMINER

ZHAO, YU

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/586,703	Applicant(s) GUTTA ET AL.	
	Examiner YU ZHAO	Art Unit 2169	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 June 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20 July 2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. **Claims 1-21** are presented for examination.
2. The claims and only the claims form the metes and bounds of the invention.
“Office personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim are not read into the claim. In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969)” (MPEP p 2100-8, c 2, I 45-48; p 2100-9, c 1, I 1-4). The Examiner has full latitude to interpret each claim in the broadest reasonable sense. The Examiner will reference prior art using terminology familiar to one of ordinary skill in the art. Such an approach is broad in concept and can be either explicit or implicit in meaning.

Priority

3. It is acknowledged that the pending application claims priority to provisional application **60/537,810** filed **January 20, 2004**. Priority date of **January 20, 2004** is given.

Information Disclosure Statement

4. The information disclosure statement (IDS) submitted on **July 20, 2006** is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claims Worksheet

5. Claims worksheet (PTO-2022) submitted on **June 25, 2008**, marked Claim 1 is the only independent claim. However, claim 16 is also an independent claim.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

Claim 1 recites “**An e-book system...**” claimed as computer listings per se, i.e., the descriptions or expressions of the programs are not physical “things.” They are neither computer components nor statutory processes, as they are not “acts” being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer, which permit the computer program’s functionality to be realized.

The claim lacks the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material per se.

Claims 2-15 are rejected with the same reason as above.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-4, 6, 8, 9, 12, 15, 16, 17, 19 and 21 are rejected under 35

U.S.C. 102(b) as being anticipated by Miyasaka et al. (U.S. Patent No.: 6,990,633

B1, hereinafter, Miyasaka).

For claim 1, Miyasaka discloses an e-book system comprising:

a searcher that is configured to locate segments of a plurality of publications based on a user profile (Miyasaka: column 2, lines 7-9, “a personalized presentation of news and information is provided to a recipient by obtaining preferences of the recipient”, column 2, lines 20-22, “obtaining content information that represent at least part of the content of each selected document”),

a compiler, operably coupled to the searcher, that is configured to create an e- book from the segments (Miyasaka: column 2, lines 3-7, “to provide a computer-network based newspaper having content that can be selected and presented in a form according to personal preferences of an individual recipient.”, column 2, lines 20-24, “obtaining content information that represent at least part of the content of each selected document; and generating a representation of articles including the content information such that a presentation of the representation conforms to the preferred presentation layout.”).

For claim 2, Miyasaka discloses the e-book system of claim 1, further including:

a manager that is configured to create the user profile, based on interactions with a user (Miyasaka: column 5, lines 47-52, “news server 5 requires an individual to setup a subscription by registering individual information in profile database 42. The form shown in FIG. 5A is one example that allows an individual to register for a new subscription, or to review and modify current preferences for an existing subscription.”).

For claim 3, Miyasaka discloses the e-book system of claim 1, wherein the system is further configured to notify a user of the e-book that is created by the compiler (Miyasaka: column 3, lines 33-36, “method 30 includes step 35 that delivers the representation to a destination specified by the recipient. For example, step 35 may send the generated representation by electronic mail (e-mail) to an address included in the profile.”).

For claim 4, Miyasaka discloses the e-book system of claim 3, wherein the system is further configured to effect a transfer of the e-book to the user (Miyasaka: column 17, lines 60-67, “If the recipient has requested delivery of a newspaper document or a list...such as conventional mail or e-mail...stored and made available for viewing or downloading...”).

For claim 6, Miyasaka discloses the e-book system of claim 1, wherein the system is configured to modify the user profile based on subsequent activities of a user (Miyasaka: column 19, lines 6-9, "receives indications of recipient activity with respect to the formatted newspaper and revise profile information to reflect changes in a recipient's preferred topics, subtopics and keywords.").

For claim 8, Miyasaka discloses the e-book system of claim 1, wherein the searcher is configured to search Internet sites to locate the segments (Miyasaka: column 1, lines 26-27, "...global computer networks such as the Internet provide an additional source of information.", column 1, lines 31-33, "Each document or resource that is made accessible through the Internet...").

For claim 9, Miyasaka discloses the e-book system of claim 1, wherein the compiler is configured to format the e-book based on preferences of a user (Miyasaka: column 2, lines 22-24, "generating a representation of articles including the content information such that a presentation of the representation conforms to the preferred presentation layout.").

For claim 12, Miyasaka discloses the e-book system of claim 1, wherein the user profile includes at least one of: a topic of interest, a keyword, an author, and a publisher (Miyasaka: column 3, lines 23-25, "the profile includes indications of desired topics for news articles...").

For claim 15, Miyasaka discloses the e-book system of claim 1, wherein the compiler is further configured to filter the segments to provide select segments corresponding to the user profile in the e-book (Miyasaka: column 2, lines 7-9, “a personalized presentation of news and information is provided to a recipient by obtaining preferences of the recipient”, column 2, lines 20-24, “obtaining content information that represent at least part of the content of each selected document; and generating a representation of articles including the content information such that a presentation of the representation conforms to the preferred presentation layout.”).

Claim 16 is rejected as substantially similar as claim 1, for the similar reasons.

Claim 17 is rejected as substantially similar as claim 2, for the similar reasons.

For claim 19, Miyasaka discloses the method of claim 16, further including offering the e-book for sale (Miyasaka: column 14, lines 4-6, “These fees can be used to defray costs of providing the newspaper, thereby reducing or eliminating any charge to the recipient.”).

Claim 21 is rejected as substantially similar as claim 6, for the similar reasons.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to

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a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miyasaka et al. (U.S. Patent No.: 6,990,633 B1, hereinafter, Miyasaka) as applied to claim 1 above, in view of Murata et al. (U.S. Patent No.: U.S. 2003/0187881 A1, hereinafter, Murata).

For claim 5, Miyasaka discloses the e-book system of claim 4.

However, Miyasaka does not explicitly disclose wherein the transfer is effected in exchange for payment by the user.

Murata discloses wherein the transfer is effected in exchange for payment by the user (Murata: page 1, paragraph [0004], "...electronic document management systems for computerizing and handling documents essential for corporate activities are being put into practical use, and their consequential paper-less operation can reduce costs required for printing, sorting, delivery, storage, operation, etc. of documents"), **in order to "improve efficiency of work and quality of work"** (Murata: page 1, paragraph [0004]).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to improve upon "Providing a network-based personalized newspaper with personalized content and layout" **as taught by Miyasaka by implementing "Electronic document management method and program"** as taught by Murata, because it would provide Miyasaka's system with

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the enhanced capability of “improve efficiency of work and quality of work” (Murata: page 1, paragraph [0004]).

9. Claims 7 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyasaka et al. (U.S. Patent No.: 6,990,633 B1, hereinafter, Miyasaka) as applied to claims 1 and 16 above, in view of Habib et al. (U.S. Patent No.: U.S. 5,579,466, hereinafter, Habib).

For claim 7, Miyasaka discloses the e-book system of claim 1.

However, Miyasaka does not explicitly disclose wherein the system is further configured to modify the e-book, based on selections by a user.

Habib discloses wherein the system is further configured to modify the e-book, based on selections by a user (Habib: column 1, lines 15-32, “...a user authoring a document wishes to modify some data in the document through the use of a dialog window.”), **in order to “to replace a word in a phrase and to change the formatting of the phrase to an italicized larger font...”** (Habib: column 1, lines 17-32).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to improve upon “Providing a network-based personalized newspaper with personalized content and layout” **as taught by Miyasaka by implementing “Electronic document management method and program” as taught by Habib, because it would provide Miyasaka’s system with the enhanced capability of “to replace a word in a phrase and to change**

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the formatting of the phrase to an italicized larger font..." (Habib: column 1, lines 17-32).

Claim 20 is rejected as substantially similar as claim 7, for the similar reasons.

10. Claims 10, 11, 13 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyasaka et al. (U.S. Patent No.: 6,990,633 B1, hereinafter, Miyasaka) as applied to claims 1 and 16 above, in view of Case et al. (U.S. Patent No.: U.S. 2003/0154180, hereinafter, Case).

For claim 10, Miyasaka discloses the e-book system of claim 1.

However, Miyasaka does not explicitly disclose wherein the user profile corresponds to a profile of a generic user.

Case discloses wherein the user profile corresponds to a profile of a generic user (Case: page 1, paragraph [0010], "provides...a default profile generator that creates initial profiles for new users."), in order to "...generate default user profiles for new joiners to an organization, in dependence on their role" (Case: page 1, paragraph [0011]).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to improve upon "Providing a network-based personalized newspaper with personalized content and layout" as taught by Miyasaka by implementing "Profile management system" as taught by Case, because it would provide Miyasaka's system with the enhanced capability of

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“...generate default user profiles for new joiners to an organization, in dependence on their role” (Case: page 1, paragraph [0011]).

For claim 11, Miyasaka discloses the e-book system of claim 1.

However, Miyasaka does not explicitly disclose wherein the searcher is further configured to locate the segments of publications based on a hierarchy of user profiles.

Case discloses wherein the searcher is further configured to locate the segments of publications based on a hierarchy of user profiles (Case: page 2, paragraph [0032], “a Web search engine 18, which searches for information that may be relevant to a user; a new interest suggesting agent 21, which proactively identifies interests of relevance to a user; an “over-the-shoulder” information retrieval agent 20, which monitors the behavior patterns of users; and a “matchmaking” agent 19, which identifies groups of users having similar interests to the user.”), in order to “provide collaborative working functions across a user group” (Case: page 2, paragraph [0032]).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to improve upon “Providing a network-based personalized newspaper with personalized content and layout” as taught by Miyasaka by implementing “Profile management system” as taught by

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Case, because it would provide Miyasaka's system with the enhanced capability of "provide collaborative working functions across a user group" (Case: page 2, paragraph [0032]).

For claim 13, Miyasaka and Case disclose the modified e-book system of claim 11, wherein the user profile further includes at least one of: a maximum segment length, a maximum complexity level, and a maximum text-to-figure ratio (Miyasaka: column 13, lines 33-49, "the recipient may be allowed to specify a maximum or preferred length of an article presentation...A "maximum" article length specifies a certain limit on a presentation. A "preferred" article length allows some flexibility in the process that generates the presentation.").

Claim 18 is rejected as substantially similar as claim 11, for the similar reasons.

11. **Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miyasaka et al. (U.S. Patent No.: 6,990,633 B1, hereinafter, Miyasaka) as applied to claim 1 above, in view of Lawrence (U.S. Patent No.: U.S. 2005/0071328 A1).**

For claim 14, Miyasaka discloses the e-book system of claim 1.

However, Miyasaka does not explicitly disclose wherein the user profile includes an identification of segments that are already possessed by a user.

Lawrence discloses wherein the user profile includes an identification of segments that are already possessed by a user (Lawrence: page 11, claim 18,

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"each user profile including at least a user's identification number and information derived from documents visited by the user"), in order to "helpful in determining the user's preferences." (page 3, paragraph [0031]).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to improve upon "Providing a network-based personalized newspaper with personalized content and layout" as taught by Miyasaka by implementing "Personalization of web search" as taught by Lawrence, because it would provide Miyasaka's system with the enhanced capability of "provide collaborative working functions across a user group" (Case: page 2, paragraph [0032]).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to YU ZHAO whose telephone number is (571)270-3427. The examiner can normally be reached on Monday-Friday 7:30am-5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tony Mahmoudi can be reached on (571) 272-4078. The fax phone number for the organization where this application or proceeding is assigned is 571-270-4427.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Date: 8/28/2008

/Yu Zhao/

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